

### **REMARKS**

Claims 13-27 are pending. Claims 13, 17 and 21 were amended to recite inherent features of the presently claimed invention. Claims 13 and 17 were further amended to improve their grammar.

No new matter was added. Support for the new claim language appears in at least the following text portions of the original specification: page 4, lines 26-27; page 7, lines 20-24; page 12, lines 16-17; and page 15, lines 17-18.

### **Request for Interview Prior to Formal Action on Amendment**

Applicants request an interview prior to formal action on this response. An "Applicant Initiated Interview Request Form" accompanies this response. Please contact Applicants' undersigned representative to schedule the interview.

### **Specification Objection**

#### **1. Procedural issues**

The objection to the specification is identical to the objection made in a previous Office Action dated August 18, 2008, except for the last sentence that appears in the outstanding Office Action that offers a suggestion to amend the specification to include specific examples of computer readable media.

Applicants fully responded to the specification objection in the "Response After Final Under 37 C.F.R. § 1.116" filed on November 26, 2008. See pages 3-4 of this response.

An Advisory Action mailed on December 11, 2008 includes the following statement by the Examiner (underlining added for emphasis)

In response to the remarks examiner regarding objection, the examiner withdraws the object to the specification.

That is, the Examiner stated that the specification objection was withdrawn.

Notwithstanding this statement, the outstanding rejection includes the same specification objection. Furthermore, the outstanding rejection does not provide any substantive response to the arguments made by Applicants in the November 26, 2008 response as required by examination guidelines. Paragraph 15 of the outstanding rejection states that “Applicant’s arguments with respect to claims 13-27 have been considered but are moot in view of the new grounds of rejection.” However, as noted above, the specification objection is not a new grounds of rejection, and thus a substantive response to Applicants’ previous arguments is required since an RCE was filed, assuming that the specification objection is being reinstated. The Examiner’s new statement at the end of the specification objection in the outstanding Office Action is not a substantive response to Applicants’ arguments. Nor is it a helpful suggestion because the Examiner does not identify where support exists in the original specification for making the proposed amendment.

2. Substantive response to specification objection (repeated from 11/26/08 response)

The specification was objected for allegedly not providing a proper antecedent basis for the limitation “computer-readable medium” in claims 17-20. Applicants respectfully traverse this objection because the specification clearly supports this claim limitation and because the format of claims 17-20 is explicitly permitted by the USPTO as discussed in MPEP 2106.01, Section I.

Page 15, lines 22-26 of the present specification reads as follows:

The present invention can be included in an article of manufacture (e.g., one or more computer program products) having, for instance, computer useable media. The media has embodied therein, for instance, computer readable program code means for providing and facilitating the mechanisms of the present invention. The article of manufacture can be included as part of a computer system or sold separately.

This text portion clearly supports the claim limitation of a “computer readable medium.” Furthermore, Appendices A-C and E show source code (i.e., computer-executable instructions) that become encoded on the computer-readable medium.

The Examiner states that the claimed “computer-readable medium encoded with computer-executable instructions” is interpreted as a computer program on a “shelf” that is waiting to be executed by a computer, and that this should be treated as a claim for a computer program which is nonstatutory functional descriptive material. Applicants respectfully traverse this characterization of the claimed invention.

Claims 17-20 are directed to an “article of manufacture” which is a physical thing, such as a computer program product. For example, it may be a diskette or a memory stick that contains software code, that when executed, performs the claimed steps. This is an entirely permissible claim format used to capture potential infringement by entities such as software retailers or distributors who are not performing the claimed process themselves, and are not selling hardware that meets an apparatus claim (e.g., software executing on a computer), but instead are selling software via an article of manufacture that performs the claimed process when loaded into a computer.

Furthermore, the Examiner’s position is contrary to USPTO policy, as clearly stated in MPEP 2106.01, Section I (underlining added for emphasis).

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory....When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.

Applicants’ claim language is explicitly permitted by the USPTO and cannot be characterized as nonstatutory functional descriptive material.

For at least the reasons set forth above, withdrawal of the specification objection is respectfully requested.

3. Examiner remarks in rescinded Office Action dated June 11, 2009

In the paragraph numbered 17 of the rescinded Office Action dated June 11, 2009, the Examiner responded to Applicants' arguments in the "Request for Supplementary Action"<sup>2</sup> that the outstanding rejection includes the same specification objection as previously given and does not provide any substantive response to the arguments made by Applicants in the November 26, 2008 response as required by examination guidelines.

Applicants have carefully reviewed the Examiner's comments in paragraph 17 and note that they merely repeat the grounds of the specification objection. Thus, Applicants are unable to provide any further amendments or arguments.

Applicants earnestly wish to advance prosecution of this application and cannot do so with respect to this issue based on the outstanding Office Action because the Examiner's position is unclear regarding the specification objection.

**Rejection under 35 U.S.C. § 101**

Claims 13-16 and 21-27 were rejected under 35 U.S.C. § 101 for allegedly reciting non-statutory subject matter. Applicants respectfully traverse this rejection for at least the reasons set forth below.

In the outstanding Office Action, the Examiner provides the following arguments to support the rejection:

1. The claims do not meet the "machine-or-transformation test" set forth in *In re Bilski*<sup>3</sup>.
2. The steps of "constructing a web page and inserting script into the web page are broad enough that the claim could be completely performed mentally, verbally or without a machine

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<sup>2</sup> Applicants' undersigned representative was informed by Examiner Flynn in a phone call dated May 12, 2009 that this request is being denied and that a communication to this effect will be mailed out. To date, no such communication has been received.

<sup>3</sup> A claimed process is patent-eligible under § 101 if:  
(1) it is tied to a particular machine or apparatus, or  
(2) it transforms a particular article into a different state or thing

nor is any transformation apparent. For example a web page can be constructed on the piece of paper that allows receipt of digital asset.”

Regarding the Examiner’s second argument, a web page cannot be constructed on a piece of paper because a constructed web page must be rendered, typically by a browser, and code written on a piece of paper cannot be rendered in a browser. The very act of constructing a web page inherently requires machine elements. While source code of a web page or an artist’s rendition of a web page could be written out on a piece of paper, rendering that code into something that is humanly recognizable requires machine elements.

Appendix A of this paper shows various definitions of a “web page.”<sup>4</sup> All of these definitions require the presence of the Internet and/or a web browser. For example, the definition of a web page as being a “document connected to the World Wide Web and viewable by anyone connected to the internet who has a web browser” requires the Internet and a web browser.

Notwithstanding the arguments above, to advance prosecution of the patent application, claim 13 was amended to recite “electronically constructing a web page from source code” and claim 17 was amended to recite “means for electronically constructing a web page from source code.” The claims now explicitly require machine elements to perform the recited function since it would be impossible to electronically construct a web page from source code without machine elements. Furthermore, the new language explicitly precludes the claimed invention from being constructed on a piece of paper.

Lastly, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), attached hereto as Appendix B. Here, the specification unequivocally describes machine elements for constructing a web page and inserting script into the web page. See, for example, the machine elements in Figures 1 and 16. Nothing even

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<sup>4</sup> Printout of various definitions of “web page” from Google definitions feature, printout date: June 20, 2009, 2 pages.

remotely similar to a paper process is described. Accordingly, an artisan would interpret the claimed web page construction process as being machine-implemented.

Regarding the Examiner's first argument, as discussed above, the claims are clearly tied to a particular machine or apparatus. Furthermore, the claims also transform a particular article into a different state or thing. Here, a digital asset in a repository becomes incorporated into a web page for viewing by a user, thereby transforming the digital asset into a usable piece of content which can be rendered in a web page.

For at least the reasons above, claims 13 and 17 are believed to be statutory.

### **Rejection under 35 U.S.C. § 102**

All pending claims were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Truong<sup>5</sup>. Applicants respectfully traverse this rejection.

#### **1. Truong**

Truong discloses a remote system administration method that allows files stored at a remote server to be retrieved (and edited, if desired) via a web browser resident on a client machine. In this manner, a user does not need to rely upon specialized communication software to gain access to such files. Truong operates as follows for retrieving editable files:

- a. An editor input form (also, referred to in Truong as a "network editor input page") is received at a forms-enabled and script-enabled web browser through a network from a server in response to a request from a client.
- b. The web browser resident on the client then performs the following functions:
  - i. Sends a server path input to the server from the web browser.
  - ii. Receives a file selection form from the server. The file selection form includes filenames identifying files included in a server path defined by the server path input.
  - iii. Sends a file selection from the web browser to the server. The file selection identifies one of the files.

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<sup>5</sup> Page 4 of the Office Action states that claims 13-24 are rejected, but it is presumed that the Examiner meant to refer to claims 13-27 because claims 25-27 are discussed on page 5 of the Office Action.

- iv. Receives a copy of the one of the files from the server.
- v. Edits the copy of the one of the files using the web browser without the use of a plug-in to the web browser to produce an updated file.
- vi. Sends the updated file to the server for storage.

If the retrieved files are marked as being “not editable,” then steps v. and vi. are not performed.

Truong uses embedded script code to facilitate this process. However, the embedded script code does not include either of the elements required by the code of the inserted script recited in the claimed invention, namely (i) a uniform resource identifier (URI) of a web page for use by a remote site in authenticating whether the URI is authorized to receive the content of the digital asset, and (ii) a unique identifier of the content of the digital asset.

Truong’s embedded script code is used for a completely different purpose than the inserted script of the claimed invention. While Truong discusses URL’s and an authentication process that verifies logon ID’s and passwords, neither of these elements (i) or (ii) are included in code of the inserted script. Truong discusses how the embedded script code is used in the following text portions (underlining added for emphasis):

FIG. 2 is a block diagram illustrating client 12 and a remote Internet server 15 configured as a remote editor system 26...A logon script 41 may also be stored in client memory 48 and is provided as an embedded script from an Internet web page. Logon script 41 is discussed more fully below.  
(column 6, lines 12-24)

Web browser 32 is also a script-enabled browser which enables it to interpret HTML formatted web pages that include embedded script within the HTML code. The embedded script is provided to web browser 32 at client 12 for enhanced processing at client 12. The embedded script may be provided in JAVASCRIPT format or any other scripting language format that is provided to a web browser at a client for enhanced processing.  
(column 7, lines 1-8)

Once a desired web page is retrieved, web browser 32 may receive formatting information and embedded script from a file defining the web page. The file defining the web page is generally located at a remote Internet server, such as remote Internet server 15 as shown in FIG. 2. Typically, web browser 32 receives the information in HTML format and the embedded script in JAVASCRIPT format so that the web page may be interpreted and processed using processor 34 and web browser 32 of

client 12 and then graphically displayed at client 12. Often, a web page will contain user selectable icons that are preprogrammed with the URL of a related web page so that a user may conveniently navigate the Internet by selecting these icons. (column 7, lines 20-32)

Remote editor program 40 is an application program shown loaded into server memory 46. Remote editor program 40 is stored in mass storage device 44 and is then loaded into server memory 46 when selected by a user. This may occur when a user of client 12, while accessing the Internet using web browser 32, requests a particular web page that will automatically load remote editor program 40 into server memory 46. In response, HTML code and any embedded script may be provided to web browser 32. For example, logon script 41, as shown in client memory 48 with web browser 32, may be provided to client 12 where it is processed using web browser 32 and processor 34. (column 8, lines 3-16)

Remote editor program 40, discussed more fully below in connection with FIGS. 3A through 3C, 4, 5, and 6, communicates an editor input form, including HTML code and embedded script code, to web browser 32 of client 12. In response, client 12 preferably prompts the user for an input including a logon ID, a password, and a remote server path using a web page, such as that shown in FIGS. 3A through 3C. Remote editor program 40 may be implemented using a common gateway interface ("CGI") program, called a script, that receives the input from web browser 32 of client 12, processes the input and executes other programs of remote Internet server 15 as necessary, and provides any results to web browser 32 in HTML format. Appendix A includes some sample code of one such implementation of the editor input form of remote editor program 40. (column 8, lines 3-16)

The logon ID, password, and remote server path inputs identify a particular user and whether the user has access rights to remote Internet server 15. Logon script 41, provided by remote editor program 40 through the editor input form, is stored in client memory 48 and is interpreted by web browser 32 to determine whether text has been entered into the logon ID input and the password input. Assuming that text has been entered, the inputs are communicated back to remote editor program 40 of remote Internet server 15 as an input text string. Remote editor program 40 receives the input text string from the client and parses the input text string to identify a server path input. This server path input identifies a particular path at remote Internet server 15. Assuming that the user provided a valid logon ID and password, as provided through the input text string, remote editor program 40 stores the server path input as a variable and generates a file selection form. The file selection form includes the text of the file names identifying files included in the server path defined by the server



path input. Remote Internet server 15, under the control of remote editor program 40, communicates the file selection form to the client in HTML format. (column 8, lines 17-37)

FIGS. 3A through 3C depict a flow chart illustrating an exemplary method of using remote editor system 26. The method begins at step 100 and proceeds to step 102 where a web browser application program is executed at a client and the client in turn connects to the server of an Internet service provider. At step 104 a user enters the URL of a network editor web page stored on a remote Internet server. Next, at step 106 the remote Internet server provides the network editor web page to the web browser at the client. The network editor web page may also be referred to as an editor input form and preferably includes a first part, generally provided in HTML format to the web browser or the client, and is used to generate an input screen at the client. The network editor web page preferably also includes a second part, generally provided in JAVASCRIPT format, that is provided to the web browser of the client so that the client may perform local processing such as logon script 41 of FIG. 2. The network editor web page includes HTML code and JAVASCRIPT code. (column 9, lines 1-19)

The method proceeds next to step 108 where the web browser displays the network editor web page at the client. The network editor web page provides input fields for a logon ID input, a password input, and a remote server path input such as that shown in FIGS. 4, 5, and 6. Then at step 110 a user provides a logon ID, a password, and a remote server path as an input at the web browser of the client. (column 9, lines 20-26)

At step 112 the web browser, using the embedded logon script provided in step 106, performs processing to ensure that the logon ID and password fields are not empty. The logon script simply checks to ensure that something has been entered in both of these inputs. At decision step 114 it determines whether the logon ID input or the password input are empty. If so, at step 116, a message is displayed at the web browser of the client indicating that a valid logon ID and password must be entered to access the system. The method then returns to step 108 where the user has the opportunity to enter a valid logon ID and password. Otherwise, the method at decision step 114 proceeds to step 118. (column 9, lines 27-39)

As highlighted above, Truong uses the embedded logon script to create the editor input form (network editor input page) and to facilitate entry of data fields into the editor input form.

However, the editor input form does not contain as part of its code, nor does it facilitate entry of (i) a uniform resource identifier (URI) of a web page for use by a remote site in authenticating

whether the URI is authorized to receive the content of the digital asset, or (ii) a unique identifier of the content of the digital asset. In contrast to Truong, the code of the inserted script in the claimed invention requires both of these elements.

In the outstanding Office Action, the Examiner states that these elements are disclosed in column 7, lines 20-33 and column 8, lines 3-16 of Truong. Applicants respectfully traverse the relevance of these text portions of Truong to such elements. These text portions read as follows (underlining added for emphasis):

Once a desired web page is retrieved, web browser 32 may receive formatting information and embedded script from a file defining the web page. The file defining the web page is generally located at a remote Internet server, such as remote Internet server 15 as shown in FIG. 2. Typically, web browser 32 receives the information in HTML format and the embedded script in JAVASCRIPT format so that the web page may be interpreted and processed using processor 34 and web browser 32 of client 12 and then graphically displayed at client 12. Often, a web page will contain user selectable icons that are preprogrammed with the URL of a related web page so that a user may conveniently navigate the Internet by selecting these icons. (column 7, lines 20-33)

Remote editor program 40, discussed more fully below in connection with FIGS. 3A through 3C, 4, 5, and 6, communicates an editor input form, including HTML code and embedded script code, to web browser 32 of client 12. In response, client 12 preferably prompts the user for an input including a login ID, a password, and a remote server path using a web page, such as that shown in FIGS. 3A through 3C. Remote editor program 40 may be implemented using a common gateway interface ("CGI") program, called a script, that receives the input from web browser 32 of client 12, processes the input and executes other programs of remote Internet server 15 as necessary, and provides any results to web browser 32 in HTML format. Appendix A includes some sample code of one such implementation of the editor input form of remote editor program 40. (column 8, lines 3-16)

The URL discussed in column 7, line 30 is not part of the embedded script code described in Truong. This text portion merely states the well-known fact that an icon can have a URL embedded therein. Furthermore, the conventional icon-related URL does not require authentication to determine if the user can receive the web page or content associated with the icon-related URL.

Column 7, lines 20-29 of Truong merely describes how a web page receives information in HTML, and also describes that the web page can include embedded script, such as Javascript. Nothing in this text portion relates to (i) a uniform resource identifier (URI) of a web page for use by a remote site in authenticating whether the URI is authorized to receive the content of the digital asset, or (ii) a unique identifier of the content of the digital asset.

Column 8, lines 3-16 of Truong describes two types of script, namely, (i) embedded script code in the browser (logon script 41 that checks that something has been entered into logon ID and password fields before sending a request to a server), and (ii) a CGI program that executes at the server, receives form data from the browser, generates file name text for each server file stored in the directory identified by the server path input variable, and returns the file names to the client machine for display. A remote server path is not a unique identifier of content of a digital asset. A remote server path is merely a location or directory where content may reside. For example, Fig. 4 of Truong shows a remote server path that includes eight files.

Furthermore, the authentication that is performed in Truong at the server (i.e., did the user provide a valid logon ID and password?) merely checks that the user is entitled to receive the file names and their content. This has nothing to do with using a uniform resource identifier (URI) of a web page in authenticating whether the URI is authorized to receive the content of a digital asset.

Neither of the scripts described in column 8, lines 3-16 of Truong include any code that relates to (i) a uniform resource identifier (URI) of a web page for use by a remote site in authenticating whether the URI is authorized to receive the content of the digital asset, or (ii) a unique identifier of the content of the digital asset. Nor do any other portions of Truong disclose or suggest such code.

## 2. Patentable differences between Truong and claimed invention

Except for the fact that Truong discloses that script may be inserted into a web page, which Applicants are not claiming to have invented, Truong has nothing whatsoever to do with the claimed invention. The following table provides a snapshot view of the deficiencies in Truong:

Claim language	Portions of Truong highlighted by Examiner	Applicants' rebuttal comments
13. A method of constructing a web page that allows for receipt of digital assets, the method comprising:	Examiner asserts that Truong provides this function.	Truong does not disclose constructing a <u>web page</u> , even under Truong's own definition of a web page, as described in column 1, lines 42-50. For example, the output displays shown in Figs. 4 and 5 do not show a web page having a unique URL. At best, Fig. 4 shows a listing of editable files, and Fig. 5 shows coding that may <u>describe</u> a web page, but nothing in the coding allows for receipt of digital assets.
(a) electronically constructing a web page from source code; and	Figs. 4 and 5	Truong does not disclose constructing a <u>web page</u> , even under Truong's own definition of a web page, as described in column 1, lines 42-50. For example, the output displays shown in Figs. 4 and 5 do not show a web page having a unique URL. At best, Fig. 4 shows a listing of editable files, and Fig. 5 shows coding that may <u>describe</u> a web page.
(b) inserting script associated with at least one digital asset that is desired to be part of a fully rendered web page into the web page,	column 2, lines 17-31	At best, this background text portion of Truong merely discloses that script may be inserted into a web page. (As noted above, Applicants are not claiming to have invented constructing a web page that includes script.). Nothing in this text portion discusses that Javascript is "associated with at least <u>one digital asset that is desired to be part of a fully rendered web page.</u> " Furthermore, Truong's invention is not even using Javascript for this purpose. Instead, Truong merely uses Javascript for a logon script 41 to check that something has been entered into logon ID and password fields before sending a request to a server.
the inserted script including code to request the content of the digital asset	server file, column 10, lines 5-14	Column 10, lines 5-14 merely describes the process of generating file name text for each server file stored in the directory identified by the server path input variable, as shown

		<p>in Fig. 4. This process simply generates a directory listing of whatever files happen to be located at the path, regardless of their content characteristics or ability to edit or view them. Stated another way, the request that occurs in Truong does specifically ask for “digital assets.” In fact, there may be <u>no</u> digital assets at all located at the path. The request in Truong will merely return whatever files are located at the path.</p> <p>Thus, to the extent that the logon script 41 is used in a process that requests files from a server, there is no code in the logon script 41 that requests <u>content</u> of a digital asset.</p>
from a remote site when the code is executed by a browser,	column 8, lines 3-16	<p>Column 8, lines 3-9 merely describes logon script 41 that is used to check that something has been entered into logon ID and password fields before sending a request to the server. As discussed immediately above, this request is not a request for content of a digital asset.</p> <p>Column 8, lines 9-16 discusses script (CGI program) that receives form data from the browser and is executed at the <u>server</u>, not at the browser, so this portion of Truong is not relevant. Furthermore, the server-executed script also does not request the content of a digital asset. Instead, it generates file name text for each server file stored in the directory identified by the server path input variable and returns the file names to the client machine for display.</p>
the code including: (i) a uniform resource identifier (URI) of the web page for use by the remote site in authenticating whether the URI is authorized to receive the content of the digital asset, and	column 7, lines 20-33 and column 8, lines 3-16	<p>As discussed above, the URL discussed in column 7, line 30 is <u>not</u> part of the embedded script code described in Truong. This text portion merely states the well-known fact that an icon can have a URL embedded therein. Furthermore, the icon-related URL does not require <u>authentication</u> to determine if the user can receive the web page or content associated with the icon-</p>

<p>(ii) a unique identifier of the content of the digital asset.</p>		<p>related URL.</p> <p>Column 7, lines 20-29 merely describes how a web page receives information in HTML, and also describes that the web page can include embedded script, such as Javascript. Nothing in this text portion relates to (i) a uniform resource identifier (URI) of a web page for use by a remote site in authenticating whether the URI is authorized to receive the content of the digital asset, or (ii) a unique identifier of the content of the digital asset.</p> <p>Column 8, lines 3-16 of Truong describes two types of script, namely, (i) embedded script code in the browser (logon script 41 that checks that something has been entered into logon ID and password fields before sending a request to a server), and (ii) a CGI program that executes at the server, receives form data from the browser, generates file name text for each server file stored in the directory identified by the server path input variable, and returns the file names to the client machine for display. A remote server path is not a unique identifier of content of a digital asset. A remote server path is merely a <u>location or directory</u> where content may reside. For example, Fig. 4 of Truong shows a remote server path that includes eight files.</p> <p>Furthermore, the <u>authentication</u> that is performed in Truong at the server (i.e., did the user provide a valid logon ID and password?) merely checks that the user is entitled to receive the file names and their content. This has nothing to do with using a uniform resource identifier (URI) of a web page in authenticating whether the URI is authorized to receive the content of a digital asset.</p> <p>Neither of the scripts described in column 8, lines 3-16 of Truong include any code that</p>
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		relates to (i) a uniform resource identifier (URI) of a web page for use by a remote site in authenticating whether the URI is authorized to receive the content of the digital asset, or (ii) a unique identifier of the content of the digital asset. Nor do any other portions of Truong disclose or suggest such code.

### 3. Patentability of independent claims 13, 17 and 21 over Truong

Claim 13 reads as follows (underlining added for emphasis):

13. A method of constructing a web page that allows for receipt of digital assets, the method comprising:  
 (a) electronically constructing a web page from source code; and  
 (b) inserting script associated with at least one digital asset that is desired to be part of a fully rendered web page into the web page, the inserted script including code to request the content of the digital asset from a remote site when the code is executed by a browser, the code including:  
     (i) a uniform resource identifier (URI) of the web page for use by the remote site in authenticating whether the URI is authorized to receive the content of the digital asset, and  
     (ii) a unique identifier of the content of the digital asset.

As discussed above, and as summarized in the table, Truong does not disclose or suggest any of the above-highlighted features in claim 13. Accordingly, claim 13 is believed to be patentable over Truong.

Claims 17 and 21 are also believed to be patentable over Truong for the same reasons as applied to claim 13.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP 2131. Here, none of the claimed elements are disclosed in Truong. Accordingly, withdrawal of the prior art rejection is respectfully requested.

4. Patentability of dependent claims

The dependent claims are believed to be patentable over the applied references for at least the reason that they are dependent upon allowable base claims and because they recite additional patentable elements and steps.

**Conclusion**

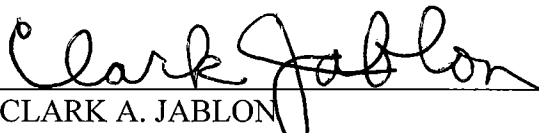
Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. Issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

RICHARD D. MARTIN et al.

June 22, 2009  
(Date)

By: \_\_\_\_\_

  
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Enclosures: Appendix A (2 pages)

Appendix B (2 pages)



# APPENDIX A

Web Images Video Maps News Shopping Gmail more ▾

[Sign in](#)

Google

define: web page

Search

[Advanced Search](#)  
[Preferences](#)

Related phrases: [static web page](#) [dynamic web page](#) [web page design](#) [electric guitar web page](#) [ltd web page](#) [laser focus world web page](#) [classic mask web page](#) [cord web page](#) [push web page technologies](#)

## Definitions of **web page** on the Web:

- a document connected to the World Wide Web and viewable by anyone connected to the internet who has a web browser  
[wordnet.princeton.edu/perl/webwn](http://wordnet.princeton.edu/perl/webwn)
- A web page or webpage is a resource of information that is suitable for the World Wide Web and can be accessed through a web browser. This information is usually in HTML or XHTML format, and may provide navigation to other web pages via hypertext links.  
[en.wikipedia.org/wiki/Web\\_page](http://en.wikipedia.org/wiki/Web_page)
- Alternative spelling of web page  
[en.wiktionary.org/wiki/web-page](http://en.wiktionary.org/wiki/web-page)
- a single page in a website, together with any referenced images or scripts etc; often hyperlinked to others  
[en.wiktionary.org/wiki/web\\_page](http://en.wiktionary.org/wiki/web_page)
- A document written in HTML that can be accessed on the Internet. Every Web page has a unique address called a URL. Web pages can contain text, graphics, and hyperlinks to other web pages and files.  
[www.bugclub.org/glossary.html](http://www.bugclub.org/glossary.html)
- A document designed for viewing in a web browser. Typically written in HTML. A web site is made of one or more web pages.  
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to show injury caused by actual confusion only because the summary judgment was limited to the plaintiff's claim for damages. In the plaintiff in *Schuit* had made other claims, claims not for damages (in the traditional sense) but for equitable relief such as a request for defendant's profits on any unjust enrichment theory, the plaintiff's failure to show injury caused by actual confusion would have been insufficient to support summary judgment against it. See *Roulo*, 886 F.2d at 941. Thus, the rule for the particular case in *Schuit*, a case involving a claim for damages only, cannot be generalized to fit all claims arising under the Lanham Act. It cannot be generalized to fit the claims in this case.

Accordingly, we reverse the judgment of the district court.<sup>4</sup> In so doing, however we wish to disturb none of the court's findings of fact and as little as possible of its legal analysis. WPC has shown that Oxy-Dry violated section 43(a) of the Lanham Act. It has not shown, however, that it is entitled to a "grant of monetary damages." Whether it is entitled to a recovery of some or all of the defendant's profits, or to a recovery of its attorneys' fees or litigation costs, we do not decide. We leave those issues on remand for the district court.

Reversed and remanded for further proceedings consistent with this opinion. Circuit Rule 36 shall not apply.

<sup>4</sup> As WPC's amended complaint clearly shows, WPC prayed for more than just damages. In addition to asking the district court to award damages, WPC asked the district court, among other things, to award WPC Oxy-Dry's profits and WPC's costs, expenses and reasonable attorneys' fees.

<sup>5</sup> In addition to entering judgment for Oxy-Dry on WPC's Lanham Act claim, the court below entered judgment for Oxy-Dry on related state law claims pressed by WPC. The court concluded that the legal principles governing the Lanham Act also governed "WPC's common law claim of unfair competition and WPC's claims under the Illinois Consumer Fraud and Deceptive Business Practices Act, Ill. Rev. Stat. ch. 121½, §§262, 311-1/2." The court then held "that WPC has failed to prove these claims for the same reason that it failed to prove its claim under the Lanham Act." We have noted, however, that the district court was wrong in interpreting the principles governing the Lanham Act. It follows that the district court erred in holding that WPC had failed to establish a "claim" under state law, assuming, *arguendo*, that the same principles of law apply to the state actions as apply to those brought pursuant to the Lanham Act.

## Court of Appeals, Federal Circuit

In re Bond

No. 90-1023

Decided August 3, 1990

### PATENTS

#### 1. Patentability/Validity — Anticipation — Prior art (§115.0703)

##### Patent construction — Claims — "Means" claims (§125.1307)

Board of Patent Appeals and Interferences' rejection, as anticipated by prior art, of claim which provides, through combination of control means, first circuit means, second circuit means, and delay means, for telephone answering machine to be set to answering mode remotely, must be vacated, in view of lack of any finding of structural equivalence between claim's delay means and means embodied in prior art device.

#### 2. Patentability/Validity — Obviousness — Relevant prior art (§115.0903)

##### Patentability/Validity — Obviousness — Combining references (§115.0905)

Board of Patent Appeals and Interferences erred in rejecting claim for remote turn-on control system for telephone answering machine on grounds that use of microcomputer to achieve delay means was obvious, since board's factual findings show that cited references would not have suggested claimed invention to one of ordinary skill, and since board's analysis was based on hindsight reconstruction of claimed invention.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Application for patent of Raymond G. Bond, serial no. 840,007, filed March 17, 1986. From decision affirming examiner's final rejections of both claims of patent, applicant appeals. Vacated in part, reversed in part, and remanded.

Keith D. Beecher, of Jessup, Beecher & Stehofer, Santa Monica, Calif., for appellant.

Muriel E. Crawford, assistant solicitor (Fred E. McKelvey, with her on brief), for appellee.

Before Baldwin, senior circuit judge, Archer, circuit judge, and Tashima, district judge (Central District of California, sitting by designation).

### Per curiam.

This appeal is from the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences (Board), Appeal No. 89-1286, dated June 30, 1989, affirming the examiner's final rejection of both claims of Raymond G. Bond's patent application Serial No. 840,007, filed March 17, 1986, entitled "Remote Turn-on Control System for Telephone Answering Machine." We vacate-in-part, reverse-in-part and remand.

### I

The application involves one of the remote control features of a telephone answering machine, the remote turn-on feature. The machine owner who forgot to set the machine to answer (e.g., it was set to play back messages) can call the machine and set it to answering mode remotely by ringing the phone a certain number of times. Once the machine is set, it will remain in this mode and answer calls until it is set to another mode. In this respect, the application involves technology essentially identical to the device patented by Curtis, et al., U.S. Patent No. 3,723,636 (Curtis).

Bond claims a combination of the above technology and a delay means which would prevent the machine from answering the owner's initial call for a predetermined period of time after it has set itself to answer (claim 1). Bond argues that the prior art does not leave sufficient time to hang up after setting the machine to answer, and the owner therefore may incur toll charges. Claim 1 was rejected under 35 U.S.C. §102 over Curtis. Bond also claims the use of a microcomputer containing an internal counter to implement the control and delay structures (claim 2). Claim 2 was rejected under 35 U.S.C. §103 over Curtis in view of Hanscom.<sup>1</sup>

<sup>1</sup> Hanscom was awarded U.S. Patent No. 4,400,586 for a "Remote Message Repeat Control For Telephone Answering System." Hanscom's claimed invention includes a means for retrieving messages remotely using a "beeper" to alert the machine that it should perform that function. The Hanscom specification provides that the essential control functions are performed by a microcomputer.

### II

The Board affirmed the examiner's rejection of claim 1. "For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference." *Di-versitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). These elements must be arranged as in the claim under review. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984), but this is not an "ipsissimis verbis" test. *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 & n.11, 1 USPQ2d 1241, 1245 & n.11 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). "[A]nticipation is a fact question subject to review under the clearly erroneous standard." *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

Claim 1 provides for a combination of control means, first circuit means, second delay means, and means included in said control means for delaying the seizure of said telephone line by said second circuit means for a predetermined time interval after said telephone answering machine has been set to said automatic answering mode so as to permit the calling party to get off the telephone line and avoid telephone charges.

"It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. [...] and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983) (citations omitted). The specification provides that this delay is implemented through digital means as follows:

[W]hen the telephone answering machine is so set to the automatic answer mode, an internal counter in the microcomputer Z107 delays the time until pin 31 goes high, so that actual line seizure is delayed. This permits the calling party to get off the line before any toll charges are assessed.

Once pin 31 "goes high," the answering machine immediately seizes the line. By contrast, seizure of the line is delayed in the Curtis device through analog means.<sup>2</sup> A

<sup>2</sup> The board found that "Curtis disclosed a delay means (R1-R5, C3-C4 and the fixed time between rings) which delays the seizure of the

IV

classical example of a hindsight reconstruction of the claimed invention.

Bond's claimed invention includes a microcomputer which functions to delay seizure of the telephone line once the device has been set to the automatic answering mode. The Board found that the Curtis device experiences some delay after it has been energized and before it seizes the telephone line. Such a delay is only inherent in the Curtis system and Curtis neither places any importance on this delay nor specifically notes that line seizure should be further deferred. Hanscom, the secondary reference, discloses a familiar telephone answering machine that employs a microcomputer which delays seizure of the telephone line until after a preset number of rings, while using a microcomputer to count the number of incoming rings. Hanscom is silent with respect to whether a device like that disclosed by Curtis should embody a delay following activation of the answering mode and before line seizure, or how such a delay should be implemented. For the purpose of its combination with Curtis, the Hanscom patent merely discloses that microcomputers can be used as a means for counting telephone rings entering an automatic answering machine.

[2] When the claimed invention is contrasted with the Curtis and Hanscom devices, a distinct difference becomes apparent — the claimed invention embodies a microcomputer placed within the system which delays seizure of the telephone line for a predetermined period of time following activation of the device's answering mode. Unless the Curtis and Hanscom disclosures would have suggested to one of ordinary skill in the art at the time the invention was made that a microcomputer should be so employed, claim 2 is not unpatentable under 35 U.S.C. §103 on this record. See *Unifroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51, 5 USPQ2d 1434, 1438 (Fed. Cir.) *cert. denied*, 109 S.Ct. 75 (1988). On balance, we conclude, given the factual findings of the Board (including the finding that the Curtis device does contain some structure which is involved in producing the inherent delay in seizing the telephone line after activation of the automatic answering mode, see footnote 2, *supra*), that even though the Curtis device does experience some inherent delay, the cited references would not have suggested the claimed invention to one of ordinary skill. Neither reference expressly or implicitly suggests that a microcomputer assembly should be embodied in a Curtis-like device in such a manner as would produce the inherent, yet unmentioned, delay experienced by the Curtis device.

III

The Board rejected claim 2, which depends from claim 1, on the ground that the use of a microcomputer to achieve the delay would have been obvious to one skilled in the art. "A determination that an invention would have been obvious under §103 is a conclusion of law based on fact. [ ] The degree to which the determination involves facts, and is thus subject to the 'clearly erroneous' standard ... is that degree required to erect a foundation of facts sufficient to support the legal conclusion." *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 1423, 8 USPQ2d 1323, 1327 (Fed. Cir. 1988) (citations omitted). See also *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985).

Claim 2 modifies claim 1 by defining the control and delay means thereof as "comprising [ ] a microcomputer having an internal counter to delay the seizure of said telephone line until the counter reaches a predetermined count." In its opinion, the Board stated:

Curtis discloses an analog circuit for counting calls [sic, rings]. ... Hanscom discloses that it was conventional to count calls [rings] digitally in a telephone answering machine by means of a microcomputer. ... We hold that the artisan, having the suggestions of Curtis and Hanscom before him at the time the invention was made, would have found it manifestly obvious to combine these teachings to obtain the subject matter of claim 2.

We are convinced that this holding does not recognize that there are critical differences between the claimed invention and the prior art. See *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) (the difference between the claimed invention and the prior art is one of the four factual inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103). It also does not reflect the admonition of this court that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *Carrella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986); see also *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Board's analysis is a

are the ring signals heard by calling and called parties.

delay occurs between the time the machine sets to answer — in response to, for example, the tenth ring signal — and the seizure of the line — which takes place only on receipt of the next ring signal.

[1] The disclosed and prior art structures are not identical, but the claim may nonetheless be anticipated. While a "means-plus-function" limitation may appear to include all means capable of achieving the desired function, the statute requires that it be "constructed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. §112 ¶6 (emphasis added); see *In re Iwahashi*, 888 F.2d 1370, 1375 n.1, 12 USPQ2d 1908, 1912 n.1 (Fed. Cir. 1989) (applying §112 ¶6 to PTO proceedings, and harmonizing prior case law); *Johnston v. Ivac Corp.*, 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989) ("section 112 ¶6 operates to cut back on the types of means which could literally satisfy the claim language," (emphasis in original)). However, the Board made no finding that the delay means of claim 1 and that embodied in the Curtis device are structurally equivalent. Accordingly, its decision as to the anticipation of claim 1 is deficient and must be vacated. Since structural equivalency under section 112 ¶6 is a question of fact, see *Pennwalt Corp. v. Durand-Wayland*, 833 F.2d 931, 933-34, 4 USPQ2d 1737, 1739 (Fed. Cir. 1987) (*in banc*), the court will not reach that question in the first instance.

telephone line for a predetermined time after the machine has been set." It would seem from our review of the Curtis disclosure that resistors R1-R5 and capacitors C3 and C4 do not function to produce any delay after the device is energized, i.e., set to the automatic answering mode. Rather, their role seems to be limited to producing the delay that precedes the energizing of the answering device. If our understanding of the Curtis disclosure is correct, the delay experienced by the Curtis device between the time the device is energized and the time it seizes the telephone line is a function solely of the fixed time between telephone rings, which delay is not produced by structure within the Curtis device. In view of our vacatur and remand of the board's decision regarding claim 1 on other grounds, we need not further consider the question of whether there is structure in Curtis to delay seizure of the line after the device is energized.

The board found that in the Curtis device "the line is not seized immediately but only after one additional ring" (emphasis added); the Curtis specification discloses that the incoming call is answered by the answering machine "on" the next ring. See col. 4, lines 16-17.

In light of this disposition, the court need not resolve the question of how closely synchronized

classical example of a hindsight reconstruction of the claimed invention.

Bond's claimed invention includes a microcomputer which functions to delay seizure of the telephone line once the device has been set to the automatic answering mode. The Board found that the Curtis device experiences some delay after it has been energized and before it seizes the telephone line. Such a delay is only inherent in the Curtis system and Curtis neither places any importance on this delay nor specifically notes that line seizure should be further deferred. Hanscom, the secondary reference, discloses a familiar telephone answering machine that employs a microcomputer which delays seizure of the telephone line until after a preset number of rings, while using a microcomputer to count the number of incoming rings. Hanscom is silent with respect to whether a device like that disclosed by Curtis should embody a delay following activation of the answering mode and before line seizure, or how such a delay should be implemented. For the purpose of its combination with Curtis, the Hanscom patent merely discloses that microcomputers can be used as a means for counting telephone rings entering an automatic answering machine.

[2] When the claimed invention is contrasted with the Curtis and Hanscom devices, a distinct difference becomes apparent — the claimed invention embodies a microcomputer placed within the system which delays seizure of the telephone line for a predetermined period of time following activation of the device's answering mode. Unless the Curtis and Hanscom disclosures would have suggested to one of ordinary skill in the art at the time the invention was made that a microcomputer should be so employed, claim 2 is not unpatentable under 35 U.S.C. §103 on this record. See *Unifroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51, 5 USPQ2d 1434, 1438 (Fed. Cir.) *cert. denied*, 109 S.Ct. 75 (1988). On balance, we conclude, given the factual findings of the Board (including the finding that the Curtis device does contain some structure which is involved in producing the inherent delay in seizing the telephone line after activation of the automatic answering mode, see footnote 2, *supra*), that even though the Curtis device does experience some inherent delay, the cited references would not have suggested the claimed invention to one of ordinary skill. Neither reference expressly or implicitly suggests that a microcomputer assembly should be embodied in a Curtis-like device in such a manner as would produce the inherent, yet unmentioned, delay experienced by the Curtis device.

IV

In conclusion, the Board's decision is (1) vacated insofar as it holds that the invention of claim 1 of Bond's application is anticipated by the Curtis device; (2) reversed insofar as it holds that claim 2 is unpatentable under 35 U.S.C. §103 over Curtis in view of Hanscom; and (3) remanded. On remand, the Board should consider whether the delay experienced by the Curtis device after activation of the answering mode and before seizure of the telephone line is caused by any "structure" within the Curtis device and, if so, whether this "structure" is equivalent to that disclosed in Bond's specification as exemplified by the claim 1 delay means. Only if each of these inquiries is answered in the affirmative is the invention defined in claim 1 anticipated by the Curtis disclosure.

VACATED-IN-PART, REVERSED-IN-PART, and REMANDED.

Court of Appeals, Federal Circuit

Rosemount Inc. v. U.S. International Trade Commission

No. 90-1263

Decided August 2, 1990

PATENTS

1. U.S. International Trade Commission — Remedies (§155.07)

U.S. International Trade Commission — Appeals (§155.09)

International Trade Commission's exercise of its authority to grant temporary relief in proceeding under Tariff Act's Section 337, 19 USC 1337, should parallel factors considered by federal district court in determining whether to grant injunction prior to trial; commission's exercise of that authority will be reviewed on appeal under abuse of discretion standard.

REMEDIES

2. Non-monetary and injunctive — Equitable relief — Preliminary injunctions — Patents (§505.0707.07)

Presumption of irreparable harm may be afforded to patent owner who has made strong preliminary showing of patent valid-